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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,453	08/16/2001	Akihiro Ouchi	862.C2332	1321

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EXAMINER

HOLTON, STEVEN E

ART UNIT PAPER NUMBER

2673

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,453

Applicant(s)

OUCHI ET AL.

Examiner

Steven E. Holton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)*
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is made in response to applicant's amendment filed on 06/09/2005. Claims 1-17 are currently pending in the application. An action follows below:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9, 11, 14, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al. (USPN: 4931965), hereinafter Kaneko, in view of Marks (USPN: 5615364).

Regarding claims 1 and 16, which are drawn to a device and associated method of operation, Kaneko discloses, "An electronic board apparatus (Fig. 1) for transmitting data representing a handwritten image written on a predetermined board (Fig. 1, element 8) to an external computer (col. 4, lines 15-18), comprising:

Storage means for storing said data (Fig. 1, in element 1, labeled 'RAM' and col. 16, lines 28-34)." However, Kaneko does not expressly disclose, "means for determining whether or not said external computer can receive said data; and... wherein if it is determined that said external computer cannot receive said data, said data is stored into said storage means." Marks discloses a system for database storage

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of data on a database and an external backup database computer. Marks discusses that when the main computer detects a network failure the connection is broken and the system waits to reconnect. During that time, operations (data) are stored for later transmission when the communications link is reestablished (col. 3, lines 51-60).

Kaneko and Marks are related in the transmission of electronic data between a system and external computer system. At the time of invention it would have been obvious to one skilled in the art to provide a method of handling situations when the connection between electronic board and external computer of Kaneko became disrupted or broken. The motivation for doing so would be to protect against a failure within the communications system. Thus, it would have been obvious to one skilled in the art to produce an electronic writing input device communicating with an external computer system to store data locally if the connection to an external computer failed or was broken to produce a device and related method of operation as specified in claims 1 and 16.

Regarding claim 2, Marks discloses a system where if the external computer can receive data the data is transmitted to the external computer. This is shown in Fig. 2, between elements named "send DB operation to backup over network" and "place operation in pending queue". If the connection fails, then the information is stored to the queue to be transmitted later. If the connection is successful then the information is transmitted immediately and not saved.

Regarding claim 3, Marks discloses a system where a stored queue of previous communications are sent when the receiving computer is able to receive the data (col. 3, lines 57-60).

Regarding claim 4, Kaneko does not expressly disclose what would be part of the coordinate information used by the input device, but the device uses a pen for input purposes and does not specify exact locations on the input device where the user could not properly input. Therefore, it would be very possible for a user of the system to input images that would include characters, letters, figures, tables or any other data that can be made using a pencil and paper. These types of images cover the limitations of claim 4.

Regarding claim 5, Kaneko discloses an input apparatus that is regarded as "a coordinates input apparatus (abstract, line 1). The device represents all input data as coordinate information. Such information would represent any handwritten images that are input on the device, and teach the limitations of claim 5.

Regarding claims 6 and 17, these claims are a device and related method of operation. Kaneko discloses, "further comprising display means (fig. 1, element 11) for displaying said handwritten image based on said data." The examiner notes that a device using the limitations of claim 6 could then be operated using the method disclosed by claim 17.

Regarding claim 7, Kaneko does not expressly disclose that the display means could display an image based on the data stored in the storage means, however, the display can receive coordinate information directly from the processor of the device, it

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would be just as able to send coordinate information from a stored location in the memory of the device. This would produce a device as specified in claim 7.

Regarding claim 8, Kaneko discloses, "...wherein a display device to display said handwritten image based on said data is connectable to said apparatus (col. 4, lines 5-8)." Kaneko discusses that the device can send the coordinate information to an external computer or other device. A computer can be used as a display device and the connection could also be made to send data directly to a monitor or other visual display device.

Regarding claim 9, the Examiner takes Official Notice that it is well-known in the art to use a timing means to transmit electronic data over a network. The timing means is used to synchronize the data as it is transferred so that information is sent in distinguishable packets that can be read by the receiving system without confusion.

Regarding claim 11, the Examiner takes Official Notice that is old and well-known in the art to allow for removable memory cards such as computer disks and other similar devices for storage of information for a portable device. Therefore, it would have been obvious at the time of invention for one skilled in the art to allow the memory device used to store coordinate information to be removable from the input device. This would allow the user to expand the amount of memory available and allow for transport from the device to a base station for later reproduction or retrieval.

Regarding claim 14, the examiner notes that the limitations of this independent claim are a combination of the limitations and preamble of claim 1. Because of the

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similarities of the limitations of the two claims, the arguments used to reject claim 1 are used to reject claim 14.

3. Claims 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko in view of Marks as applied to claims 1 and 14 above, and further in view of Bricklin et al. (USPN: 5539427), hereinafter Bricklin.

Regarding claim 10, as shown above, the combination of Kaneko and Marks disclose all of the limitations of claim 1 that are part of claim 10; however, they do not expressly disclose, "wherein said data, to which page break or index information is added, is stored." Bricklin discloses a graphic indexing system used to store graphic information for recall at a later time. The system allows the user to select a portion of the input graphic data to be index information, and then stores associated text with the index information.

Bricklin is analogous art because he deals with text and handwritten input on an electronic pad device. At the time of the invention it would have been obvious to one skilled in the art to use an indexing system similar to the system defined by Bricklin to store multiple entries on a board input apparatus constructed from the combination of Kaneko and Marks. The motivation for doing so would have been to allow for more than one page of information to be input using the handwriting device, and that the information could be retrieved for re-display. Therefore, it would have been obvious to use a graphic indexing system combined with a handwriting input device to produce an input apparatus as specified in claim 10.

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Regarding claim 15, as shown above, the combination of Kaneko and Marks disclose all of the limitations of claim 14 that are part of claim 15. Kaneko also discloses, "display means for displaying said handwritten image based on said data (Fig. 1, element 11)." However, neither Kaneko nor Marks expressly disclose, "selection means for selecting one of a first mode and a second mode,

Wherein said first mode, said display means displays said handwritten image based on said data from said data generation means,

And wherein said second mode, said display means displays said handwritten image based on said data stored in said storage means."

Bricklin discloses a system for indexing and retrieval of graphically input data. There is no specifically mention a selection means for picking one mode or another, such a means must exist within the system because a user is able to both enter new data and retrieve old data. When entering new data, the coordinates of the inputted information will be shown as quickly as inputted because the user can "select a portion of the text for indexing without disrupting the natural handwriting action (abstract, lines 10-12)." If the images were not displayed from the recently input data, the flow of handwriting would be interrupted. Thus this input style is the same as the claimed 'first mode' of operation. When the user reviews the indexed information in the system, stored information can be shown and this corresponds to the claimed 'second mode' of operation. Thus, the combination of an indexing and review method as disclosed by Bricklin with a handwriting input device as disclosed by the combination of Kaneko and Marks would produce a device as specified in claim 15

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4. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko in view of Marks as applied to claim 1 above, and further in view of Davis et al. (USPN: 6232962), hereinafter Davis.

Regarding claims 12 and 13, as shown above, the combination of Kaneko and Marks disclose all of the limitations of claim 1 that are part of claims 12 and 13. Davis discloses a detector assembly (Fig. 7D, element 72) that can be "attached along the top, bottom, or side of the writing surface (col. 42, lines 3-4)." This device therefore can be 'provided at one end of the board' as part of claim 12 and could be 'removable from said board' as part of claim 13.

Davis is analogous art because he deals with a board input apparatus for use as a handwriting input system. At the time of invention it would have been obvious to one skilled in the art to enclose a sensor device as disclosed in the combination of Kaneko and Marks in a movable and detachable housing as taught by Davis. The motivation for doing so would have been to provide a device that was portable and able to be positioned as needed for a specific input or display function, such as moving from one room to another during the middle of a presentation. The device could be taken down and moved to another area and the presentation restarted without any data lost or extra setup of a new system required. Thus, it would have been obvious to embody a handwriting board input apparatus in a portable housing to produce a device as disclosed in claims 12 and 13.

Response to Arguments

5. The amendments to the specification have been reviewed and are acceptable.
6. The amendment to claim 10 has been reviewed and the objection of claim 10 has been withdrawn.
7. Applicant's arguments, see page 10, lines 2-9, filed 6/9/2005, with respect to the rejection(s) of claim(s) 1-17 under USC 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art references as discussed above.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven E. Holton whose telephone number is (571) 272-7903. The examiner can normally be reached on M-F 8:30-5.

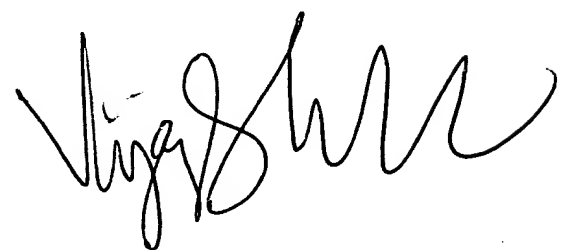
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (571) 272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.E.H.
August 22, 2005

Steven E. Holton
Examiner
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A handwritten signature in black ink, appearing to read 'Vijay Shankar', with a stylized, flowing script.

VIJAY SHANKAR
PRIMARY EXAMINER